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Urgent

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Date: October 12, 2004

To:
Examiner: Neil Abrams
USPTO

Fax:
(703) 872-9306

Art Unit:
2839

From:
Stuart A. Whittington

Fax:
(480) 715-7738

M/S:
OC2-157

Subject:

Application No.: 09/024,885; Inventor: David Roth

Filed: 2/17/1998

Docket No. P12193XCX

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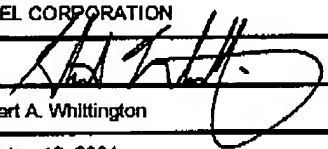
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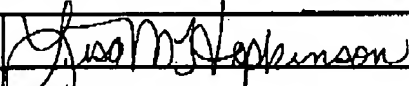
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/024,885	
	Filing Date	2/17/1998	
	First Named Inventor	David Roth	
	Art Unit	2839	
	Examiner Name	Nell Abrame	
Total Number of Pages in This Submission	26	Attorney Docket Number	P12193XCX

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☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$)**340.00****Complete if Known**

Application Number	09/024,885
Filing Date	2/17/1998
First Named Inventor	David Roth
Examiner Name	Neil Abrams
Art Unit	2839
Attorney Docket No.	P12193XCX

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SUBTOTAL (1) (\$)**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 88	2201 44	Independent claims in excess of 3
1203 300	2203 150	Multiple dependent claim, if not paid
1204 88	2204 44	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

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1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 430	2252 215	Extension for reply within second month	
1253 980	2253 490	Extension for reply within third month	
1254 1,530	2254 765	Extension for reply within fourth month	
1255 2,080	2255 1,040	Extension for reply within fifth month	
1401 340	2401 170	Notice of Appeal	
1402 340	2402 170	Filing a brief in support of an appeal	340.00
1403 300	2403 150	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 65	Petition to revive - unavoidable	
1453 1,370	2453 685	Petition to revive - unintentional	
1501 1,370	2501 685	Utility issue fee (or reissue)	
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1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
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1810 790	2810 395	For each additional invention to be examined (37 CFR 1.129(b))	
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(Complete if applicable)

Telephone **480-715-3895**

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Attorney Docket No.	P12193XCX

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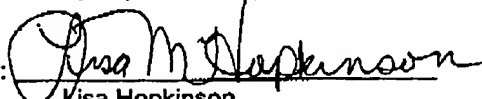
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of David Roth et al.

Atty. Docket No: P12193XCX

Appln. No.: 09/024,885

Group Art Unit: 2839

Filed: February 17, 1998

Examiner: Abrams, Neil

Title: VERSATILE COMMUNICATIONS CONNECTOR

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BRIEF ON APPEAL

In response to the Advisory Action dated May 28, 2004 and pursuant to Appellant's Notice of Appeal filed on August 10, 2004, Appellant presents this Brief and fee under 37 C.F.R. § 1.17(c) in appeal of the Final Rejection dated February 10, 2004.

I. REAL PARTY IN INTEREST.

Intel Corporation is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES.

There are no related appeals or interferences before the Board of Patent Appeals and Interferences known to Appellant, the Appellant's legal representatives, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

APPELLANT'S BRIEF
U.S. Appl. No. 09/024,885

III. STATUS OF CLAIMS.

A total of claims 1-163 have been pending in the application and their status is as follows:

Claims 1-79, 86-93, 95-116, 127, 129-132 and 157-163 are cancelled;

Claims 128 and 141-143 are allowed; and

Claims 80¹-85, 94, 117-126, 133-140 and 144-156 stand finally rejected and are the claims subject to this appeal. Appendix A includes a copy of the claims subject to this Appeal.

IV. STATUS OF AMENDMENTS.

An amendment under 37 C.F.R. § 1.116 was submitted on May 6, 2004 in response to the Final Action of February 10, 2004. While not expressly indicated, Appellant presumes this amendment has been entered based on the indication in the Advisory Action of May 25, 2004 that claims 128 and 141-143 are allowed².

V. SUMMARY OF CLAIMED SUBJECT MATTER.

Embodiments of the instant invention relate to communication connectors for electronic devices such as computers, fax machines, modems, and/or local area network (LAN) adapters. (Specification pg. 2, ll 15-19). Communication devices often require some type of convenient

¹ Appellant requests clarification of the rejected claims in the Examiner's Answer. For example, the Advisory Action of May 28, 2004 indicates that independent claim 80 is both rejected (e.g., see Advisory Action summary and third paragraph of pg. 2) and allowed (e.g., see last paragraph of Advisory Action pg. 2).

² Claims 128 and 141-143 were previously objected to in the Final Office Action.

APPELLANT'S BRIEF
U.S. Appln. No. 09/024,885

attachment to a communication line. For example, many devices have adaptors and housings for accommodating RJ-11, RJ-12, RJ-45 (referred to as RJ-xx type connectors) or other types of connectors. (Spec. pg. 2, ll. 20 through pg. 3, ll. 4). However, as communication devices become smaller and more portable, such as devices which may be compliant with specifications of the Personal Computer Memory Card International Association (PCMCIA), incorporation of customary RJ-xx sized receptacles becomes more difficult. (Spec. pg. 3, ll. 8-21). Further, prior art attempts to address this issue have resulted in various connection arrangements which do not adequately protect electrical contacts of the connectors or are prone to breakage due to inherently weak structures. (Spec. pg. 4, ll. 7-15)

Referring to Appellant's independent claims 80, 133 and 139 and Figs. 22-23, by way of example, a device (e.g., 351; Fig. 22) is claimed which includes a card body (e.g., 351B) and a receptacle module (e.g., 351A). (Spec. pg. 56, ll. 5-14). The receptacle module includes a portion for removable insertion into the card body to form a unitary module. (Fig. 22-23; Spec. pg. 57, ll. 3-12). The overall length of the unitary module is preferably and substantially within the PCMCIA Type III standard. (Spec. pg. 61, ll. 10-12; Fig. 23).

In other embodiments, referring to independent claims 124, 128 and 150 and Figs. 24A and 24B, the communication card may include a sliding drawer (e.g., 394 A-C) having a movable bottom to move downward when the sliding drawer is open to receive RJ-xx series plug(s) and to shield electrical conductors of the plug(s) from a surrounding environment. (Spec. pg. 62, ll. 1-6).

APPELLANT'S BRIEF
U.S. Appln. No. 09/024,885

In yet further embodiments, referring to independent claim 144 and Figs. 12, 13 and 22, a card for use with a data utilization device includes a pivoting cover (e.g., 208, Fig. 12; 362, Fig. 22) provided on a first end of the card. (Spec. pg. 55, ll. 21 to pg. 56, ll. 4). The pivoting cover is provided for receptacles (e.g., RJ-xx series receptacles). With the pivoting cover in the closed position, the components of the connector may be protected. With the pivoting cover in an open position, a plug (e.g., RJ series plug 10) may be inserted into the recess formed by the pivoting cover. A portion of the cover (e.g., a groove or ledge 366) engages the plug 10 and holds conductors in the card in electrical contact with corresponding contacts in the plug. (Spec. pg. 59, ll. 1-5). Additional variants are disclosed and represented in the dependent claims.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL.

The issues for consideration on this appeal are:

- A. Whether the Examiner erred in rejecting claims 80-85, 94, 117-123 and 133-140 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,183,404 to Aldous et al. (hereinafter "Aldous") in view of U.S. Patent No. 4,944,698 to Siemon et al. (hereinafter "Siemon"), U.S. Patent No. 4,241,974 to Hardesty, U.S. Patent No. 4,611,875 to Clarke et al. (hereinafter "Clarke"), and/or Research Disclosure No. 317 (hereinafter "Research Disclosure");
- B. Whether the Examiner erred in rejecting claims 124-126 and 150-156 under 35 U.S.C. § 103(a) as being unpatentable over Aldous in view of U.S. Patent No. 5,395,268 to Okada (hereinafter "Okada '268");

APPELLANT'S BRIEF
U.S. Appln. No. 09/024,885

C. Whether the Examiner erred in rejecting claims 144-149 under 35 U.S.C. § 102(e) or alternatively 35 U.S.C. § 103(a) as being anticipated by or unpatentable over U.S. 5,634,802 to Kerklaan; and

D. Whether the Examiner erred in rejecting claims 144-149 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5,538,442 to Okada (hereinafter "Okada '442").

VII. ARGUMENT.

The Claims Are Patentable Over Aldous '404 In View of the Secondary References.

A. Claims 80-85, 94, 117-123 and 133-140 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Aldous in view of Siemon, Hardesty, Clarke and/or Research Disclosure. Appellant respectfully requests that these rejections be overturned for the following reasons.

It is well established that *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The mere fact that references can be combined or modified does not

APPELLANT'S BRIEF
U.S. Appl. No. 09/024,885

render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). "When the references cited by the examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

As discussed in the background section of Appellant's specification, Aldous discloses various schemes for providing a miniature RJ-11 compatible receptacle. (Specification pg. 4, ll. 3-4). However, Aldous's schemes have several disadvantages. For example, the electrical contacts of the receptacle and/or jack are left exposed to the surrounding environment which may cause electrical shock to a user and/or be susceptible to electrical shorts. Additionally, several of the Aldous configurations are inherently weak and are prone to breakage. (Specification, pg. 4, ll. 5-15).

In the instant case, the Final Office Action of 2/10/04 admits that Aldous fails to teach or suggest a receptacle module for insertion into the card body to form a unitary module (e.g., as claimed in claims 80, 133, 139). The Office Action instead relies on the secondary references to make up for this deficiency alleging "it would have been obvious to use such an adapter (referring to adaptors of secondary references) with the Aldous card 40 to provide added functions or a mating direction change." (Final Office Action 2/10/04, pg. 2). Further, the Office Action inherently admits that no references or combination discloses the unitary module (i.e., the card including the inserted receptacle module) has a length within the PCMCIA Type III standard.

It is respectfully submitted that a *prima facie* case of obviousness has not been established since: (i) there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings as suggested in the Office Action; and (ii) even when combining the cited references as suggested, the prior art references when combined fail to teach

APPELLANT'S BRIEF
U.S. Appln. No. 09/024,885

or suggest each and every claim limitation. Without both of these elements, a *prima facie* case of obviousness is not established and a rejection under 35 U.S.C. § 103(a) is improper (MPEP 2143).

(i) THERE IS NO MOTIVATION TO COMBINE REFERENCES

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Even if every element of the claimed invention is disclosed by a combination of references, without a proper motivation to combine, a rejection based on *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

In the instant case it is alleged that the various telephone adaptors disclosed by the secondary references would be obvious to combine with the card body 40 in Aldous Fig. 8. Appellant respectfully disagrees. For example, Siemon discloses a dual modular jack adapter for insertion directly on a telephone terminal block (Abstract) for use as a break testing bridge adapter (Col. 6, ll. 36-37). Appellant is unaware of any reason why the skilled artisan would conceivably need or use a break testing bridge adaptor for the PCMCIA communications card 40 disclosed by Aldous. Accordingly, there is no motivation for combining Siemon with Aldous other than piecemeal reconstruction of Appellant's claims based on hindsight of Appellant's disclosure. Such

Hardesty discloses an adapter 11 for connecting two telephone cords to a wall terminal 14 as opposed to a card body. Essentially adapter 11 is a splitter for connecting two phones to a wall terminal. While it is conceivable that adapter 11 could potentially be inserted into Aldous card 40, there is no objective reason that Appellant is aware of for doing so. Further, inclusion

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of Hardesty adapter 11 with Aldous card body 40 teaches away from a *unitary module within the PCMCIA Type III standard*.

Clarke discloses a cross-connect field power adaptor for use in connecting electrical power to a telephone station. Once again, Appellant is unaware of any conceivable purpose for combining a cross-connect field power adaptor with the PCMCIA card 40 disclosed by Aldous other than to attempt to reconstruct Appellant's claims based on impermissible hindsight.

Research Disclosure discloses a device for providing integrated digital network (ISDN) wiring termination. There is no teaching or suggestion why an ISDN wiring termination adaptor would be combined with the PCMCIA cards disclosed by Aldous and the only stated reason in the Final Office Action is "to provide added functions." Respectfully, this is not an objective reason as required to establish prima facie obviousness under 35 U.S.C. § 103(a). *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). In the 5/28/04 Advisory Action, the Examiner states that the direction change/noise reduction features "would be useful in Aldous." Respectfully Appellant disagrees.

Connecting ISDN to a computer requires a network terminator (e.g., Research Disclosure adapter) and ISDN terminal adapter. The network terminator plugs into the two wire telephone company with an RJ-11 connector and provides a four wire connection to the terminal adapter. In the U.S., the network terminator is typically built into the terminal adapter. In fact, Aldous is specifically designed to accept RJ-11 connectors (col. 11, ll. 66-67) without any intermediate adaptor. (Col. 11, ll 43-47). Consequently, not only is the ISDN terminator of Research Disclosure is entirely extraneous to Aldous, but Aldous expressly teaches away from using or needing any intermediate adaptors. For these reasons, Appellant respectfully submits the skilled artisan would not look to combine RD with Aldous.

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Since there is no proper motivation for combining the adaptors of the secondary references with the PCMCIA card disclosed by Aldous, the rejections of claims 80-85, 94, 117-123 and 133-140 under 35 U.S.C. § 103(a) are improper.

(ii) THE RESULTING COMBINATOIN FAILS TO TEACH THE CLAIMED LIMITATIONS

Even assuming that it would be proper to combine the references as suggested by the Office Action (*arguendo*), the resultant combination would still fail to teach or suggest an overall length of the unitary module (i.e., card body + receptacle module), in a configuration, that is within the PCMCIA Type III standard.

The Office Action alleges that it would be obvious to shorten the length of card 40 or form adaptors of small size. However, Appellant submits that since a unitary module having the claimed size limitations are not taught or suggested by any prior art reference or combination of references, and plainly, insertion of the various adaptors from the secondary references to the Aldous PCMCIA card body 40 would not satisfy these claimed limitations, the claims cannot be rendered obvious.

Appellant directs the Board to the URL pcwebopedia.com/TERM/P/PCMCIA.html for improved understanding which shows all PCMCIA compliant cards (Types I, II or III) have rectangular dimensions of no larger than 85.6 x 54 mm. Communications cards which meet these dimension standards cannot incorporate customary RJ-xx series receptacles because they are larger than the corresponding dimensions of the communication device. Further, when the card is not in use, the unitary module (including the removable receptacle module) may not extend beyond the host device (e.g., a laptop computer) because it is PCMCIA compliant. This is not possible with the Aldous card 40 having the various adaptors of the secondary references inserted therein.

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Because the suggested combination of prior art references is improper and because taken alone or in combination the prior art references fail to teach or suggest each and every claimed limitation, Appellant respectfully submits a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established. Accordingly, reconsideration and withdrawal of these §103 rejections are respectfully requested

B. Claims 124-126 and 150-156 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Aldous in view of U.S. Patent No. 5,395,268 to Okada (hereinafter "Okada '268"). Appellant respectfully requests this rejection be overturned for the following reasons.

Okada '268 discloses a rigid modular jack 26 fixed in a case of an IC card 28. (Col. 5, ll. 42-48). Jack 26 includes a box 40 and a bottom portion 18 of box 40 has a "function of stopping the insertion push direction of the modular plug 14." (Col. 5, ll. 54-57).

The Office Action alleges it would be obvious to combine the movable bottom 18 of Okada '268 with the pivoting retractable access portion 72 (Fig. 13) of Aldous to "provide a stop for the plug" and/or "add a degree of environment sealing for the plug contacts." Appellant respectfully submits that proposed motivation for combining the references is improper since Aldous already includes a stop for the plug. This is disclosed at Aldous col. 17, ll. 17-22 where it is stated that the communications card may be provided with a ledge 126 (Fig. 15) for preventing passage of the contact pin block completely through the aperture in the communications card. Since Aldous already discloses ledge 26 as a stop, the skilled artisan would not look to combine the movable bottom 18 of Okada '268 to "provide a stop for the plug" as alleged in the Office Action.

Moreover, Okada '268 is entirely silent that movable bottom 18 may serve to seal plug contacts from the environment, as claimed in the pending claims. Regarding modification of the

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references to provide missing elements, the Federal Circuit has stated that "modification [is not] obvious unless the prior art suggest[s] the desirability of the modification." In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984) (citations omitted); see also In re Ochjai, 71 F.3d at 1570. Here, there is no suggestion in the prior art to modify the Aldous reference to include a movable bottom element for the retractable receptacle because, inter alia, Okada '268 only includes it to provide a stop for a jack; for which Aldous already proposes a solution. Accordingly, it is respectfully submitted that the proposed modification to supply the missing elements recited in Appellant's claims is based on hindsight, impermissibly using Appellant's specification as a guide. Such piecemeal reconstruction of an applicant's claims is improper and should be avoided. MPEP § 2143.

Since no proper motivation exists for combining Okada '268 with Aldous, a *prima facie* case of obviousness has not been established and the §103 rejection of Appellant's claims based on this combination should be overturned. It is further noted that neither reference teaches or remotely suggests the bevel feature recited in dependent claim 151.

C.-D. Rejections based on Kerklaan and/or Okada '442

Claims 144-149 are rejected as being anticipated under 35 U.S.C. § 102(e) and/or unpatentable under 35 U.S.C. § 103(a) over U.S. 5,634,802 to Kerklaan or U.S. 5,538,442 to Okada (hereinafter "Okada '442"). Appellant submits that neither Kerklaan nor Okada '442 qualify as prior art against claims 144-149 since these claims are entitled to an effective filing date of November 12, 1993.

In response to the Final Office Action, Appellant directed the Examiner to Figs. 12 and 13 of the parent application, now U.S. Patent 5,411,405, which supports all of the limitations of the rejected claims.

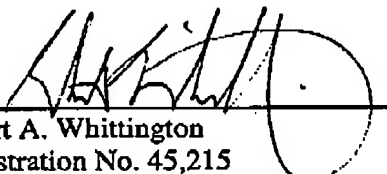
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In the Advisory Action of May 28, 2004, the Examiner states that for claim 144 "the McDaniels 405 fig. 13 pivoting cover is on adapter 200 not on the end of the card as recited in the claims and therefore does not provide adequate support for claim limitations." (Emphasis added; 5/28/04 Advisory Action pg. 2).

In rebuttal, Appellant points to col. 8, ll. 2-8 of the priority document U.S. 5,411,405 which states that module 200 includes couplings 204 so that it may be received by a communications card (e.g., on the end of modem card 118; Fig. 1). Accordingly, when module 200 is received by modem card 118, for example, the pivoting cover would be on an end of a card as recited in Appellant's claims. Consequently, all limitations of claim 144 are fully supported by the original application and Kerklaan and Okada '442 do not qualify as prior art to the instant claims.

It is respectfully submitted that in view of the foregoing all of the pending claims are patentable over the cited prior art references, alone or in any combination, and the Board is respectfully requested to overturn all rejections of record and allow this application to issue.

Respectfully submitted,


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